IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	Confirmation No.: 8438
Olivier GUITER et al.	:	Attorney Ref.: 3693.ACCESS.ASA
Serial No.: 09/942,818	:	Art Unit: 2629
Filed: August 29, 2001	:	Examiner: Alexander S. Beck

FOR: METHOD AND APPARATUS FOR DISPLAYING INFORMATION IN A DISPLAY SCREEN REGION IDENTIFIED BY PERMANENT PRINTING

RESUBMISSION OF APPEAL BRIEF

MAIL STOP: Appeal Brief
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Dear Sirs:

An Appeal Brief in the above-identified matter is resubmitted in response to the Notice of Non-Compliance of October 30, 2007. The Appeal from a Final Office Action dated July 20, 2006, finally rejecting each of the pending claims, 5, 7, 20, 24, 28 and 29.

1. REAL PARTY IN INTEREST

The real party in interest in this matter is Access Systems Americas, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

3. STATUS OF THE CLAIMS

Claims 5, 7, 20, 24, 28 and 29 are pending and have been finally rejected.

4. STATUS OF AMENDMENTS

All amendments to date have been entered.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

The invention generally relates to displaying information on a hand held device. See Specification, page 1, line 5-9.

Claim 5 recites a method for displaying information comprising displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing. See Specification, page 3, lines 17-18. The hand held device comprises a main display screen region distinct from the display screen region and the main display screen region is free of any area of permanent printing. See Specification, page 4, lines 18-19. The display screen region is implemented using a first display screen unit, and main display screen region is implemented using a second display screen unit. See Specification, page 4, lines 1-3. The method further comprises displaying computer generated information on the first display screen unit automatically in response to a signal for turning off the second display screen unit. See Specification, page 4, lines 9-11.

Claim 7 recites a method for displaying information comprising displaying computer generated information on a display screen region of a hand held device in an area identified by permanent printing. The hand held device comprises a main display screen region distinct from the display screen region, and the display screen region is free of any area of permanent printing. See Specification, page 9, lines 1-5. The display screen region is implemented

using a first display screen unit, and the display screen region is implemented using a second display screen unit. The method further comprises sending information for a clock display to the first display screen unit automatically in response to a signal for turning off the second display screen unit. See Specification, page 22, lines 21-22.

The system of claim 20 recites a hand held computer system comprising a first display screen region for displaying first computer generated information, the first display screen region identified by permanent printing. The system further comprises a second display screen region for displaying second information, wherein the first display screen region and the second display screen region are implemented as the first display screen unit and the second display screen unit and wherein the first display screen unit is configured to turn on automatically in response to a signal turning off the second display screen unit. See Specification, page 4, lines 9-11.

Claim 24 recites a method for displaying information, the method being practice in hand held computer system, the method comprising displaying program information on a main display screen region of the hand held computer system and in response to an event, displaying computer generated information on a second display screen region identified by permanent printing therein, wherein the displaying computer generated information does not interfere with the displaying program information on the main display screen region. See Specification, page 17, line 21 to page 18, line 2. Furthermore, the event may comprise an incoming phone call and the computer generated information is a dialog enabling the receipt of the phone call. See Specification, page 17, lines 21-23.

7. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants respectfully request that the rejection under 35 U.S.C. §103 of claims 5, 7, 20, 28 and 29 be reviewed on appeal. Specifically, Appellants submit that one with skill in the art would not have sufficient motivation or suggestion by a preponderance of the evidence to combine U.S. Patent No. 6,822,640 to Derocher ("Derocher"), U.S. Publication No. 2001/0044319 to Kobayashi ("Kobayashi") and the Handbook for Palm V Organizer, 1999 ("3com®") to render the claims unpatentable under Section 103.

8. ARGUMENT

A. Introduction, History and Claims

Appellants filed this application on 08/29/2001. Appellants have made several amendments to the claims to bring them into their current state as well as arguing that one of skill in the art would not have sufficient motivation or suggestion to combine cited references. Accordingly, Appellants now have appealed this case and request review of the analysis under which the prior art references have been combined.

In Appellants' response after final rejection we have cited extensively from the MPEP the balancing of burdens in establishing a *prima facie* case of obviousness. We incorporate herein by reference all of the particular citations and make special note of the legal standard of the preponderance of the evidence which requires the evidence to be more convincing for the obviousness to combine the references than the evidence which is offered in opposition to it. MPEP 2142. Appellants will summarize previous arguments as well as presenting further arguments regarding why one of skill in the art would not have sufficient motivation or suggestion to combine these references. Appellants have sought to review these references without the benefit of hindsight and to study the references to consider their suggestive power

and their teachings as a whole, including portions that would teach away from the combination.

B. Arguments

In the Final Office Action and in the response to our arguments, the Examiner asserts that

> "It is evident that the input means listed above by 3COM does not offer utilizing a touch screen region (e.g., graffiti writing area) as a sub-display for displaying computer generated information (e.g., "soft" keys, window notification, etc.), the sub-display being different than that of a main display unit (e.g., screen), as taught/suggested by DEROCHER. Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of 3COM in view of DEROCHER, as detailed above, for providing a user with another means of entering information (DEROCHER: column 7, lines 10-12).
>
> Therefore the teachings of 3COM and DEROCHER taken collectively would have suggested to one of ordinary skill in the art the displaying of computer generated information in a display screen region of a hand held device in an area identified by permanent printing (e.g., a touch screen region as a sub-display region, the sub-display being different than that of a main display unit of an electronic device)."

Appellants respectfully traverse this analysis and note that, as shall be set forth next, the teachings of 3COM and Derocher taken collectively would not have suggested to one of ordinary skill in the art the displaying of computer generated information in a display screen of a handheld device in an area identified by permanent printing. Notably, the portion of Derocher cited by the Examiner on pages 2 and 3 of the Final Office Action is column 7, lines 1-12. Here, Derocher teaches the following:

> "The use of an OLED, a touch pad that presents the appearance and performs the functions of the user-definable or 'soft' keys (F1-F2 on many standard keyboards) is used to augment or to replace these keys. Thus, applications that require input from these keys can provide the user with the opportunity to make use of the touch pad to enter this information. Further, other applications that occasionally present a window that notifies the user of a specific, required action can present this information by way of the touch pad. The touch pad can then be used to receive the required input, thus providing the user with another means of entering the required information."

There are several important characteristics of this paragraph that must be considered.

First, as is shown in Figure 1 and Figure 8, the context of the touch pad in Derocher continues to be for a standard laptop or desktop computer. For example, the reference to the "soft" keys, F1-F12 on a standard keyboard certainly leads one of skill in the art, in connection with the overall teachings of Derocher, to taking a standard touch sensitive pad on a desktop or a laptop computer and providing soft keys on that touch pad. Notably, in that context, one of skill in the art would certainly recognize that there is a separate display which is not touch sensitive and which may be connected to the standard keyboard as on a laptop or separate from the keyboard as is used in most desktop computers. There is also, as is known in the art, an element of separation between the touch pad and the display screen. Because the main display screen in Derocher is not touch sensitive and does not enable user input, the disclosure in column 7 introduces the ability of the user to use the touch pad to be presented with and select the soft keys.

The Final Office Action asserts that because the graffiti writing area of 3COM does not offer a touch screen region as a sub-display for displaying computer generated information, that it would be obvious to use the teachings of Derocher to change the graffiti writing area such that information may be displayed, presumably for the purpose of enabling a user to input information by way of a touch pad. Appellants argue that such a need would certainly not arise based in the Palm V device in 3COM for a very simple reason. As is shown on page 6 of 3COM, the screen and the graffiti writing area are positioned right next to each other. The user can already interact with the screen using a stylus. Soft keys already exist on the screen as well QWERTY keyboard as is shown on page 19. Furthermore, next to the graffiti writing area are icons which the user can tap on to proceed with functions such as open applications, menus, calendar or to find text anywhere in data as is shown on page 15. The screen area of the Palm V device may be utilized to present a variety of different images

from which the user can use the stylus to interact with the screen. For example, page 19 shows the keyboard in which the user can tap on various portions of the keyboard and select whatever letter is desired. As is known in the art, this screen can be used to present a variety of different software applications presenting "soft buttons" for the user to enable the user to make appropriate selections.

Appellants traverse the Examiner's assertion that the disclosure of Derocher in column 7 would render it obvious to one of skill in the art to modify the graffiti writing area to provide user enabled soft keys. The reason one of skill in the art would not receive a suggestion to do so is that the screen area of the Palm V device already is a touch sensitive screen and already presents user definable soft keys that are in immediate proximity to the graffiti writing area. In other words, without the benefit of hindsight one of skill in the art would view the teachings of column 7 of Derocher and realize that software programs already exist to provide soft keys on the screen that the user can interact with. This functionality already exists and is readily available and easy to use for the user of a Palm V device. Appellants respectfully submit that the analysis on page 3 of the Final Office Action goes beyond what one of skill in the art would find obvious. Appellants have invented a novel and non-obvious method in handheld computer and respectfully submit that one of skill in the art would not make the mental jumps that are outlined in the Office Action to arrive at the present invention given the ability of the Palm V device to already easily present soft keys in the screen area that is adjacent to the graffiti writing area. Hindsight is necessary to force the analysis in the Office Action.

Appellants also traverse the Examiner's analysis in the Advisory Action in response to Appellants' arguments. The Examiner broadens the scope of the teachings of Derocher beyond what is actually taught in order to favor the obviousness analysis. The Examiner does

this by misquoting the teachings of the reference to broaden the teachings beyond the scope of what fairly may be used. For example, the Examiner asserts the Derocher teaches at column 1, lines 8-11, a "hand-held computing device" the connotation that the Examiner appears to derive from this is that such a device would include Palm-like devices such as the Palm V. Thereafter, the Examiner uses the term "hand-held computing device" when referring to the teachings of Derocher. However, Appellants note that Derocher does not refer to a "hand-held computing device" but rather on line 8, teaches a "hand-held computer", a "laptop computer, or similar computing resource" wherein a touch pad is used as a graphical input device that conveys user inputs which control the operation of the computing device.

Appellants respectfully submit that without the benefit of hindsight, one would read this as well as viewing the remaining disclosure of Derocher including Figures 1-8 and realize that this deals with laptop computers or a handheld "computer" which, viewing the figures, would be understood to be a small computer having a standard QWERTY keyboard and a display. In places where Derocher references a "computing device" it is also limited to a device whose scope should be limited to a laptop computer rather than a Palm-type computer. For example, column 2, line 34 teaches a "computing device 5 includes touch pad 7, which enables the users finger (8) to control operations of the computing device." Figure 1 illustrates the "computing device 5" which is clearly too large to be a Palm-type device. This analysis supports Appellants' argument that because Derocher's teachings are limited to a laptop computer with a larger display screen and a touch pad that is used as a "mouse" to convey user inputs, that teachings in column 7 enabling the touch pad to present soft keys for selection is merely duplicative of the screen of the Palm V device and one of skill in the art would recognize it as such.

Appellants note the analysis in MPEP 2141.01 Section a.V. in which the Wang

Laboratories, Inc. v Toshiba Corp., 993 F.2d 858, 26 USPQ2D 1767 (Fed.Cir. 1993) is discussed. Here, the Federal Circuit held that the two references cited were non-analogous even though they both dealt with single in-line memory modules (SIMMs). In the present case, the Examiner is relying on the fact that the touch pad in Derocher is used to convey inputs which control the operations of the computing device where as 3COM also receives user inputs that control the operations of the computing device and thus, they are analogous and that one of skill in the art would have motivation to combine these references. However, similar to the Wang Laboratories case where both prior art references also dealt with essentially the exact same structure of single in-line memory modules, the Federal circuit found that because one SIMM related to industrial control it was not necessarily in the same field of endeavor as the subject matter of the invention which involved memory circuits and related to compact modular memories. Appellants simply note this because merely the fact that the laptop computers of Derocher have a touch pad does not necessarily mean that all other devices that have touch pads are automatically analogous and obvious to combine.

Yet another important and unexplored reason exists why one of skill in the art would not be motivated to use the Derocher concept in the graffiti area of 3COM. As noted above, column 7, of Derocher discusses specifically the user definable soft keys which are explained to be the "F1-F12" on many standard keyboards which is used to augment or replace these keys. As one of skill in the art would read that part of Derocher and then if 3COM were in from of them, then the first thing that person would do is seek to determine whether there is any information about QWERTY keyboards in 3COM. Clearly, there is. Pages 19 and 20 disclose a standard keyboard which is presented in the screen area of the Palm V device. It is the standard QWERTY keyboard that is shown with the various options to tap and modify the display. Appellants respectfully submit that this direct teaching of keyboards in both

references, rather than suggesting to one of skill in the art to use the graffiti portion to insert the F1-F12 user definable keys, but rather one of skill in the art would simply receive the suggestion to add the F1-F12 keys to the soft keyboard shown on pages 19 and 20. In this regard, the suggestion would be simply to add another row to the keyboard that already exists. Appellants respectfully submit that again given the operable standard being only by a preponderance of the evidence, that this direct teaching in each prior art reference of a standard keyboard would lead one of skill in the art toward the use of the screen area in 3COM rather than the graffiti area in 3COM to accomplish the purpose of replacing the user definable F1-F12 keys on standard keyboards in a touch sensitive display. In other words, certainly if one were to balance the suggestive power between placing these keys F1-F12 in either the standard screen in the Palm V device or the graffiti area on the Palm V device, Appellants respectfully submit that it is inescapable that the suggestion given the presentation of a keyboard on the screen, that the reference would both suggest using the standard screen and also teach away from the use of the graffiti area for the addition of such soft keys.

Appellants again respectfully assert that the objective suggestive power of Derocher is limited to a laptop or handheld computer that is controlled by operation of a user's finger on the surface. Column 7 teaches that that touch pad may include some user definable soft keys wherein the user has the opportunity to use the touch pad to effectively select one of the soft keys. This functionality is already fundamental to the Palm V device shown in 3COM and already implemented in the screen area. Accordingly, one of skill in the art in looking at these two references would not, by a preponderance of the evidence determine to display computer generated information on the first display screen unit that is distinct from the main display screen region because such functionality is easily and already implemented using the already existing touch sensitive screen area which is used to provide soft keys. Accordingly,

one of skill in the art would not have sufficient motivation, by a preponderance of the evidence, to take the teachings of Derocher and implement them in the graffiti writing area of 3COM because immediately adjacent to that writing area, such functionality already exists and is available to the user via the touch sensitive screen shown on page 6 of 3COM. Accordingly, Appellants respectfully request that the Board conclude that one of skill in the art would not, by a preponderance of the evidence, have motivation to combine 3COM with Derocher and that this appeal be remanded with instructions to the Examiner to allow the present case.

CONCLUSION

In view of the above, Appellants submit that all claims on appeal distinguish over the art and respectfully request that the Examiner's rejections of these claims be reversed. Appellants, therefore, respectfully move this Board to reverse the Examiner's decision rejecting claims 5, 7, 20, 24, 28 and 29.

The Appeal Brief fee of $500 has been paid. If necessary, the Commissioner for Patents is authorized to charge or credit the **Deposit Account No. 50-3102** for any deficiency or overpayment.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

Dated: January 30, 2008

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CLAIM APPENDIX

1-4. (Canceled)

5 . (Rejected) A method for displaying information comprising:

displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing, wherein said hand held device comprises a main display screen region distinct from said display screen region, said main display screen region free of any area of permanent printing, wherein said display screen region is implemented using a first display screen unit, and said main display screen region is implemented using a second display screen unit; and

displaying said computer generated information on said first display screen unit automatically in response to a signal for turning off said second display screen unit.

6. (Canceled)

7. (Rejected) A method for displaying information comprising:

displaying computer generated information in a display screen region of a hand held device in an area identified by permanent printing, wherein said hand held device comprises a main display screen region distinct from said display screen region, said main display screen region free of any area of permanent printing, wherein said display screen region is implemented using a first display screen unit, and said main display screen region is implemented using a second

display screen unit; and

sending information for a clock display to said first display screen unit automatically in response to a signal for turning off said second display screen unit.

8.-19. (Canceled)

20. (Rejected) A hand held computer system comprising:

a first display screen region for displaying first computer generated information, said first display screen region identified by permanent printing; and

a second display screen region for displaying second information, wherein said first display screen region and said second display screen region are implemented as a first display screen unit and a distinct second display screen unit, and wherein said first display screen unit is configured to turn on automatically in response to a signal turning off said second display screen unit.

21-23. (Canceled)

24. (Rejected) In a hand held computer system, a method for displaying information comprising:

displaying program information on a main display screen region of said hand held computer system;

in response to an event, displaying computer generated information on a second display screen region identified by permanent printing therein, wherein

said displaying computer generated information does not interfere with said displaying program information on said main display screen region; and

wherein said event is an incoming phone call and wherein said computer generated information is a dialog enabling the receipt of said phone call.

25-27. (Canceled)

28. (Rejected) The method of claim 5, further comprising:

sending information for a clock display to said first display screen unit automatically in response the signal for turning off said second display screen unit.

29. (Rejected) The hand held computer system of claim 20, wherein the handheld unit is configured to display time-of-day information on said first display screen unit automatically in response to the signal turning off the second display screen unit.

10. EVIDENCE APPENDIX

None.

11. RELATED PROCEEDINGS APPENDIX

None.